Paper No. 63

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS AND INTERFERENCES

Ex parte LARRY W. BLAKE and LEE T. NORDAN

Appeal No. 2001-2359
Application No. 08/161,194

HEARD: November 9, 2001

Before McCANDLISH, Senior Administrative Patent Judge, ABRAMS and BAHR, Administrative Patent Judges.

ABRAMS, Administrative Patent Judge.

DECISION ON APPEAL

This is a decision on appeal from the examiner's final rejection of claim 2, which is the only claim pending in this application.

We REVERSE.

BACKGROUND

The appellants' invention relates to an intraocular implant lens. The claim on appeal reads as follows:

> 2. An intraocular implant to replace the crystalline lens of a patient's eye, comprising:
> an aspheric lens formed of soft, bio-compatible material, wherein said material is silicone.

The prior art reference of record relied upon by the examiner in rejecting the appealed claim is:

Blake	5,104,590	Apr. 14, 1992

Claim 2 stands rejected under 35 U.S.C. § 102(e) as being anticipated by Blake.[1]

Rather than reiterate the conflicting viewpoints advanced by the examiner and the appellants regarding the above-noted rejection, we make reference to the Answer (Paper No. 56) for the examiner's complete reasoning in support of the rejections, and to the Brief (Paper No. 54) for the appellants' arguments thereagainst.

OPINION

[1]A rejection of claim 2 under the judicially created doctrine of obviousness-type double patenting was overcome by a terminal disclaimer filed by the appellants subsequent to the final rejection. See Papers No. 58 and 59.

In reaching our decision in this appeal, we have given careful consideration to the appellants' specification and claims, to the applied prior art references, and to the respective positions articulated by the appellants and the examiner.

The examiner has taken the position that the subject matter recited in claim 2 is anticipated by Blake. The appellants do not dispute this finding, but argue that Blake is not a proper reference because the present application is entitled to the benefit of the filing date of Blake. We agree with the appellants.

In the present application, inventors Blake and Nordan claim the benefit of the filing date of the application which matured into the Blake reference through two jointly filed intervening applications. There is no dispute that the subject matter recited in claim 2 is disclosed in the Blake reference; the examiner has cited it as an anticipatory reference and the appellants have not challenged that finding. The issue before us therefore is whether the present application can be given the benefit of the filing date of the Blake patent. In view of the change made in Section 120 by the Patent Law Amendments Act of 1984, there need not be complete identity of inventorship in order to be accorded benefit of a prior application. In re Chu, 66 F.3d 292, 297, 36 USPQ2d 1089, 1093 (Fed. Cir. 1995). Thus, since Blake is an inventor common to both the present application and the Blake patent, the application is not precluded from being accorded the benefit of the filing date of the Blake patent and, if such date were

accorded, Blake would not be a proper reference under 35 U.S.C. § 102(e) because its filing date would not antedate the effective filing date of the present application.

On the basis of the foregoing, we conclude that Blake in not a proper reference against claim 2 under 35 U.S.C. § 102(e), and the rejection will not be sustained.

SUMMARY

The rejection is not sustained.

The decision of the examiner is reversed.

REVERSED

HARRISON E. McCANDLISH Senior Administrative Patent Judge	)	
NEAL E. ABRAMS Administrative Patent Judge	)	BOARD OF PATENT APPEALS AND INTERFERENCES
JENNIFER D. BAHR Administrative Patent Judge	)	

NEA:psb

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